

### **REMARKS**

Claims 70-76 are pending in this application. Claims 70-75 have been amended. New claim 76 has been added. No new matter has been introduced.

The specification of the application has been amended to delete the Summary of the Invention and include the subject matter in the detailed description. No new matter has been introduced.

Claims 70-75 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-73 of U.S. Patent No. 6,681,778. Applicants concurrently file a Terminal Disclaimer to obviate the double-patenting rejection.

Claim 74 is rejected under 35 U.S.C. § 102(b) as being anticipated by Newlin (U.S. Patent No. 6,186,151) ("Newlin"). This rejection is respectfully traversed.

The claimed invention relates to a hair clip. As such, amended independent claim 74 recites a "hair clip" comprising "a part elongate-hollow body" and "jaws having teeth extending therefrom and wing portions for operation of said jaws and extending from said jaws, said jaws being pivotally connected to said body such that when said jaws are in a closed position said teeth mesh substantially in parallel and said body and said jaws define an elongate-hollow volume for receiving hair." Amended independent claim 74 also recites "a spring arrangement for biasing said jaws in the closed position."

Newlin relates to an apparatus for grooming and decorating hair. (Abstract; Title). Newlin teaches that hair clip 10 "includes jaws 14 and 16, each having a plurality of gripper teeth 18." (Col. 2, ll. 28-29). According to Newlin, "[w]hen the jaws are open the distal clamping ends of the jaws (the distal ends of gripper teeth 18) form a space sufficiently large to enable passage of brush 12 therethrough." (Col. 2, lines 35-37). "When, however, the jaws are closed, movement of the brush . . . is prevented." (Col. 2, ll. 38-40).

Newlin does not disclose all limitations of claim 74. Newlin fails to teach or suggest "jaws being pivotally connected to said body such that when said jaws are in a closed position said teeth mesh substantially in parallel," as amended independent claim 74 recites. In Newlin, the teeth of each jaw simply lie adjacent one another at their tips when the jaws are in the closed position. The meshing of the teeth substantially in parallel is neither taught nor suggested in Newlin. Indeed, the modification of Newlin to achieve the meshing of teeth would be significant since the teeth cannot approach one another in substantially opposed directions; they do so at an angle. The benefit of the teeth meshing substantially in parallel (as in the claimed invention) is twofold: (i) the hairclip can better sit on the wearer's head with the teeth substantially parallel to the skin of the wearer; and (ii) the volume available in the clip for holding hair is greater. In Newlin, the arrangement of the teeth in the closed position causes the teeth to face towards the skin of the wearer. This provides a design that is far less comfortable to wear and reduces the volume in the clip available for holding hair. For at least these reasons, Newlin fails to anticipate the subject matter of claim 74, and withdrawal of the rejection of this claim is respectfully requested.

Claims 70 and 73-75 are rejected under 35 U.S.C. § 103 as being unpatentable over Newlin. This rejection is respectfully traversed.

As noted above, the claimed invention relates to a hair clip. As such, amended independent claim 70 recites a "hair clip" comprising "a part cylindrical body" and "part cylindrical jaws having teeth extending therefrom in a cylindrical circumferential direction and wing portions for operation of said jaws and extending tangentially from said jaws, said jaws being pivotally connected to said body such that when said jaws are in a closed position said teeth meet and said body and said jaws define a substantially cylindrical volume for receiving hair."

Amended independent claim 73 recites a "hair clip" comprising "a part cylindrical body" and "part cylindrical jaws having teeth extending therefrom in a cylindrical circumferential direction and wing portions for operation of said jaws and extending tangentially from said jaws, said jaws being pivotally connected to said body at circumferential positions such that when said

jaws are in a closed position said teeth mesh and said body and said jaws define a region for receiving hair.”

Amended independent claim 74 recites a “hair clip” comprising “a part elongate-hollow body” and “jaws having teeth extending therefrom and wing portions for operation of said jaws and extending from said jaws, said jaws being pivotally connected to said body such that when said jaws are in a closed position said teeth mesh substantially in parallel and said body and said jaws define an elongate-hollow volume for receiving hair.”

Amended independent claim 75 recites a “hair clip” comprising “a body having a part cylindrical inner surface” and “jaws having teeth extending therefrom in a cylindrical circumferential direction, a part cylindrical inner surface, and wing portions for operation of said jaws and extending tangentially from said jaws, said jaws being pivotally connected to said body such that when said jaws are in a closed position said teeth meet and said inner surface of said body and said inner surface of said jaws define a substantially cylindrical volume for receiving hair.”

The subject matter of claims 70 and 73-75 would not have been obvious over Newlin. The Office Action fails to establish a *prima facie* case of obviousness. Applicants address below the failure of the Office Action to establish a *prima facie* case of obviousness with respect to each of independent claims 70 and 73-75:

#### Claim 70

Newlin does not disclose, teach or suggest a “part cylindrical body” or “jaws being pivotally connected to said body such that when said jaws are in a closed position said teeth meet and said body and said jaws define a substantially cylindrical volume for receiving hair,” as claim 70 recites.

The Examiner asserts that this difference between Newlin and claim 70 is a “mere change of shape.” However, the Examiner ignores the function of the shape and the reason for the difference in shape. In Newlin, the body on which the hinges are mounted provides a housing 26

for a hairbrush 12. The purpose of Newlin is providing a hairbrush combined with a hairclip. The body and the hairbrush of Newlin thus extend into the volume defined by the body and the jaws. This is clearly required to provide for the object of Newlin. However, this restricts the capacity of the volume to receive and hold hair. In contrast, the hair clip recited in claim 70 has a part cylindrical body that, in combination with the jaws, provides a substantially cylindrical volume for receiving hair that is not taught in Newlin and is certainly not suggested, since it would teach away from the provision of the integral hairbrush hidden within the hairclip.

#### Claim 73

Newlin does not disclose a “part cylindrical body,” or “jaws being pivotally connected to said body at circumferential positions such that when said jaws are in a closed position said teeth mesh and said body and said jaws define a region for receiving hair,” as claim 73 recites.

The Examiner asserts that this difference between Newlin and claim 73 is a “mere change of shape.” However, the Examiner ignores the function of the shape and the reason for the difference in shape. In Newlin, the body on which the hinges are mounted is provided to house a hairbrush. The purpose of Newlin is a hairbrush combined with a hairclip. The body and the hairbrush thus extend into the region defined by the body and the jaws. This is clearly required to provide for the object of Newlin. However, this restricts the capacity of the region to receive and hold hair. In contrast, the hair clip recited in claim 73 has a part cylindrical body which, together with the jaws, define a region for receiving hair that is not taught in Newlin and is certainly not suggested, since it would teach away from the provision of the integral hairbrush hidden within the hairclip. Further, the teeth of each jaw in Newlin merely meet at their tips and do not “mesh.” The meshing of the teeth recited in claim 73 provides an improved gripping arrangement to assist in the gripping of the larger volume of hair in the hair receiving region.

#### Claim 75

Newlin does not disclose a “body having a part cylindrical inner surface” or that the body and jaws define a substantially cylindrical volume for receiving hair, as claim 75 recites.

The Examiner states that this difference between Newlin and claim 75 is a “mere change of shape.” However, the Examiner ignores the function of the shape and the reason for the difference in shape. In Newlin, the body on which the hinges are mounted provides housing to a hairbrush. The purpose of Newlin is providing a hairbrush combined in a hairclip. The body and the hairbrush thus extend into the volume defined by the body and the jaws. This is clearly required to provide for the object of Newlin. However, this restricts the capacity of the volume to receive and hold hair. In contrast, claim 75 recites a body having a part cylindrical inner surface that, in combination with the jaws, provides a substantially cylindrical volume for receiving hair that is not taught in Newlin and is certainly not suggested, since it would teach away from the provision of the integral hairbrush hidden within the hairclip.

#### New claim 76

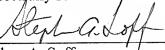
The subject matter of newly-added claim 76 would also not have been obvious over Newlin, as Newlin does not disclose, teach or suggest all limitations of claim 76. Newlin fails to disclose, teach or suggest that the jaws are provided with teeth that “mesh in a substantially parallel plane” when the jaws are in the closed position. In Newlin, the teeth of each jaw simply lie adjacent one another at an angle (when the jaws are in the closed position). The meshing of the teeth in a substantially parallel plane is neither taught nor suggested in Newlin. Indeed, the modification of Newlin to achieve this aspect of the claimed invention would be significant since the teeth cannot approach one another in substantially opposed directions: they do so at an angle.

As noted above, the benefit of the teeth meshing in a substantially parallel plane is twofold: (i) the hairclip can better sit on the wearer’s head with the teeth substantially parallel to the skin of the wearer; and (ii) the volume available in the clip for holding hair is greater. In Newlin, the arrangement of the teeth in the closed position causes the teeth to face towards the skin of the wearer. This provides a design that is far less comfortable to wear and reduces the volume in the clip available for holding hair. For at least these reasons, the Office Action fails to establish a *prima facie* case of obviousness, and withdrawal of the rejection of claims 70 and 73-75 is respectfully requested.

Allowance of all pending claims is solicited.

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